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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,545	04/18/2001	Shinpei Okajima	SN-US015055	6824

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SHINJYU GLOBAL IP COUNSELORS, LLP
1233 20TH STREET, NW, SUITE 700
WASHINGTON, DC 20036-2680

EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 04/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,545

Applicant(s)

OKAJIMA, SHINPEI

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-929)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: element 30b described on pg. 10. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Specification

3. The disclosure is objected to because of the following informalities: on pg. 13 element "66" is used for both the "control section" and the "C-clip".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United

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States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 2, 4-10, 16, 41-47 are rejected under 35 U.S.C. 102(e2) as being anticipated by Laughlin et al. '354 (referred to throughout paragraph 7 as Laughlin et al.).

Re: claims 1, 4, 5, 6. Laughlin et al. show in figure 3 a snowboard binding 3 comprising : a base member 9,29 having a front portion front 29, a rear portion shown extending from element number 9 to element number rear 29 and a longitudinal axis extending between the front and rear portions; and a rear binding member left-side 7 coupled to a first lateral side of the rear portion of the base member, the rear binding member including a first latch member left-side 17 as shown in figure 6a movable relative to the base member, the first latch member being pivotally supported about a first pivot axis 55 substantially parallel to the longitudinal axis, the first latch member being arranged to move laterally upon application of a force in a direction substantially towards the base member as shown in figures 6a and 6b.

Re: claim 2. Laughlin et al. show in figures 3 and 7 a second rear binding member right-side 7 coupled to a second lateral side of the rear portion of the base member, the second rear binding member including a second latch member right-side 17 as shown in figure 6a movable relative to the base member, the first latch member being pivotally supported about a first pivot axis 55 substantially parallel to the longitudinal axis, the first latch member being arranged to move laterally upon

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application of a force in a direction substantially towards the base member as shown in figures 6a and 6b.

Re: claims 7 and 8. Laughlin et al. show in figures 6a and 6b biasing members left and right-side 41 that urge the first and second latch members/pawls from guide positions to locking positions 21L and show guiding surfaces or unnumbered peripheral surfaces between the locking and top surfaces.

Re: claims 9 and 10. Laughlin et al. show in figure 3 the base member including a mounting portion 9 and a pair of side attachment portions extending perpendicularly from the mounting portion shown above the binding members the first and second latch members being coupled to the attachment portions indirectly via element 9. The base member further includes a highback support 13.

Re: claim 16. Laughlin et al. show in figures 3 and 6b the rear portion extending from element number 9 to element number 29 of the base member including a base plate with the first and second rear binding members mounted on support members 41 that are slanted upwardly and outwardly relative to the base plate as shown in figure 6b.

Re: claims 41-47. Laughlin et al. show in figure 3 a snowboard boot comprising: an upper portion shown above element 1 and a sole portion 23 coupled to the upper portion, the sole portion having a first rear (rear with respect to the area in the vicinity of element 23) catch portion left-side 19,21 located at a first lateral side of the sole portion and a second rear catch portion right-side 19,21 located at a second lateral side of the sole portion, the first rear catch portion including at least one first notch left-side 19,21 and the second rear catch portion including at least one second notch right-side 19,21.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin et al. '354 in view of Korman as applied to the claims above, and further in view of Laughlin et al. '909. Laughlin et al. '909 teaches in figure 3 and in col. 3 lines 12-14 the use of a rear binding member 24,28 that is longitudinally adjustable relative to the rear portion of the base member 20 such that the rear binding member can selectively be coupled at different longitudinal positions relative to the base. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the rear binding member of Laughlin et al. '354 such that it was longitudinally adjustable relative to the base, as taught by Laughlin et al. '909, in order to provide a means of accommodating a plurality of boot sizes.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin et al. '354 in view of Laughlin et al. '909. Laughlin et al. '909 teaches in figure 3 and in col. 3 lines 12-14 the use of a rear binding member 24,28 that is longitudinally adjustable relative to the rear portion of the base member 20 such that the rear binding member can selectively be coupled at different longitudinal positions relative to the base. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have modified the rear binding member of Laughlin et al. '354 such that it was longitudinally adjustable relative to the base, as taught by Laughlin et al. '909, in order to provide a means of accommodating a plurality of boot sizes.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin et al. '354 in view of French Patent 2767486 to Couderc (using US Patent 6209890 to Couderc as an English equivalent). Laughlin et al. '354 teach the use of support members extending upwardly and outwardly on which binding members are mounted, but does not include the limitation of the support members being part of a heel cup with a high back support. Couderc teaches in figure 3 the use of a binding member 4,31 mounted on a support member (which extends outwardly and upwardly relative to the base 1) as labeled in the attached copy of figure 3 of Couderc, the support member being part of a heel cup since the heel cup portion shown in the copy of figure 3 forms a part of element 1 which is a part of element 2 on which the labeled support member is found with a labeled highback support mounted thereto. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the construction of the heel cup and the base of Laughlin et al. '354 to be integral, causing the support members to be a part of the heel cup, as taught by Couderc, in order to reduce the number of parts required in the assembly of the snowboard binding to facilitate manufacturing.

10. Claims 3, 11-13, 18-36, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin et al. '354 (referred to throughout paragraph 10 as Laughlin et al.) in view of Korman.

Re: claims 3, 18, 20, 26, 27, 30, 47. Laughlin et al. show in figures 3 and 6a a snowboard binding system comprising: a snowboard boot 1 having a sole portion 23, a first rear catch portion located at a first lateral side left-side 19,43 of the sole portion and a second rear catch portion located at a second lateral side right-side 19,43 of the sole portion; and a snowboard binding 3 configured to be releasably coupled to the snowboard boot, the snowboard binding including: a base member 9,29 having a front portion front 29, a rear portion 9 extending to rear 29 and a longitudinal axis extending between the front and rear portions; a first rear binding member left-side 7 coupled to a first lateral side of the rear portion of the base member, the first rear binding member including a first latch member left-side 17,39 movable relative to the base member to selectively hold the first rear catch portion of the snowboard boot, the first latch member being arranged to move upon application of a force in a direction substantially towards the base member by the snowboard boot; and a second rear binding member right-side 7 coupled to a second lateral side of the rear portion of the base member, the second rear binding member including a second latch member right-side 17,39 movable relative to the base member to selectively hold the second rear catch portion of the snowboard boot, the first and second latch members being arranged to move laterally apart relative to each other upon application of a force in the direction substantially towards the base member by the snowboard boot, but does not include the limitations of a front catch portion located at a front part of the sole portion or a front binding member included in the snowboard binding.

Korman teaches in figure 1 a snowboard binding system having a rear binding

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member means and also incorporating the use of a snow boot having a front catch portion 30 located at a front part of the sole portion and a snowboard binding having a front binding member 66 movably coupled to the front portion of the base member 46 between a release position and a latched position to selectively hold the front catch portion as shown in figures 5 and 6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the snowboard boot and binding of Laughlin et al. to have included a front catch portion and front binding member, respectively, as taught by Korman, in order to provide a means of attaching both the front and rear portions of the boot to the snowboard to increase the security of the boot-to-board attachment.

Re: claim 19. Laughlin et al. show in figure 6b and disclose in col. 9 lines 64-65 the first and second latch members being normally urged to first and second initial positions by first and second biasing members left and right-side 65.

Re: claims 21 and 30. Laughlin et al. show in figure 7 the first (left-side) and second (right-side) pivoting axes shown in the area of line 73 being arranged substantially parallel to the longitudinal axis of the base member as broadly claimed, particularly when $C=0$ as disclosed in col. 8 line 31.

Re: claim 22. Laughlin et al. show in figure 4 the first and second latch members having first and second elongated locking surfaces (particularly the surfaces shown in the middle portion or radially innermost portion of the arc of the latch in the vicinity of number 17 in figure 4 before the arc surface turn radially outward with respect to the

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longitudinal axis), respectively, that are arranged substantially parallel (when $C=0$) to the longitudinal axis of the base member.

Re: claim 23 and 24. Laughlin et al. show in figure 4 first and second latch members having first and second elongated locking surfaces (particularly the surfaces shown below the middle or radially innermost portion of the arc of the latch in the area of the arc between number 17 and number 40, respectively, that diverge relative to the longitudinal axis of the base member as the first and second elongated locking surfaces extending from the rear portion of the base member towards the front portion of the base member.

Re: claim 25. Laughlin et al. show in figure 4 the first and second latch members having first and second elongated locking surfaces (particularly the surfaces shown in the middle portion or radially innermost portion of the arc of the latch in the vicinity of number 17 in figure 4 before the arc surface turn radially outward with respect to the longitudinal axis), respectively, that are arranged substantially parallel to the first and second axes such that the first and second locking surfaces diverge relative to the longitudinal axis of the base member (when C is not equal to zero) to the longitudinal axis of the base member.

Re: claims 28 and 29. Laughlin et al. show in figure 3 the base member including a mounting portion 9 and a pair of side attachment portions extending perpendicularly from the mounting portion shown above the binding members the first and second latch members being coupled to the attachment portions indirectly via element 9. The base member further includes a highback support 13.

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Re: claims 11, 12, and 31. Laughlin et al., as modified, teaches a front pawl 82 urged to the latched position by a front biasing member 90 and a release lever 84 coupled to the front pawl to move the pawl from the latched to the released position. See Korman figures 5 and 6 and col. 5 lines 41-43.

Re: claims 13 and 36. Laughlin et al., as modified, teaches the front binding member 66 longitudinally adjustable relative to the front portion of the base member being selectively coupled at different longitudinal positions as shown via the holes 72 arranged in series through which connecting element 76 may penetrate.

Re: claim 32-35. Laughlin et al. show in figure 3 the first and second latch members arranged to hold the first and second rear catch portions at a plurality of different heights relative to the base member (at 43 which is lower with respect to the base member and at 19,21 which is higher with respect to the base member). The notches are substantially parallel to the longitudinal axis when C=0 (see claim 21).

Re: claim 39. Laughlin et al. show in figures 3 and 6b the rear portion extending from element number 9 to element number 29 of the base member including a base plate with the first and second rear binding members mounted on support members 41 that are slanted upwardly and outwardly relative to the base plate as shown in figure 6b.

11. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin et al. '354 in view of Korman as applied to claim 39 and further in view of French Patent 2767486 to Couderc (using US Patent 6209890 to Couderc as an English equivalent). Laughlin et al. '354 teach the use of support members extending upwardly and outwardly on which binding members are mounted, but does not include the limitation of

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the support members being part of a heel cup with a high back support. Couderc teaches in figure 3 the use of a binding member 4,31 mounted on a support member (which extends outwardly and upwardly relative to the base 1) as labeled in the attached copy of figure 3 of Couderc, the support member being part of a heel cup since the heel cup portion shown in the copy of figure 3 forms a part of element 1 which is a part of element 2 on which the labeled support member is found with a labeled highback support mounted thereto. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the construction of the heel cup and the base of Laughlin et al. '354 to be integral, causing the support members to be a part of the heel cup, as taught by Couderc, in order to reduce the number of parts required in the assembly of the snowboard binding to facilitate manufacturing.

12. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laughlin et al. in view of Korman as applied to claim 47 and further in view of Turner et al. Turner teaches in figure 23 the use of a front catch portion being a U-shape member with a bight portion 658 and a pair of leg portions 672 coupled to the sole portion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the front catch portion of Laughlin et al. to have included a U-shaped member, as taught by Turner et al., in order to provide an alternate means of securing the front of the boot to the front portion of the binding.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application Numbers 09/921305, 09/921307, 09/997241, 09/997259, 09/997262, 09/997274, 09/997275, and 10/074253. Although the conflicting claims are not identical, they are not patentably distinct from each other because with regard to the claims of the instant application and those of application no. 09/997274, claims 41, 47, and 48 of the instant application and claim 1 of 09/997274 claim a snowboot with an upper portion, a sole portion, at least one rear catch, a front catch and particulars regarding the shape of the front catch. The claims of the instant application do not specify the details of the dimensions of the portions of the front catch, however, US Patent 5915720 to Laughlin et al. teach in figure 23 the use of a catch shown in the area of element number 659 having a tongue portion 659 and a pair of unnumbered leg portions, a thin width of the tongue extending laterally between the legs and the front to rearward dimension of the tongue being greater than that of the legs as shown in figure 23. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have modified the front catch of the instant invention to have included such details regarding the dimension of the front catch, as taught by Laughlin et al., in order to allow a proper connection between the front catch of the boot and a corresponding particular catch portion on the binding to promote secure attachment. Similarly, claims 1, 11, and 12 of the instant application and claim 1 of Application no. 09/997262 claim a snowboard binding system comprising a base member, a rear binding arrangement, a front binding member, the front binding member being movably coupled to the front portion of the base member to move between a latched and a released position and an indexing or biasing means. These are examples of conflicts between the claims of the instant invention and those of the abovementioned copending applications. These examples are not exhaustive. Applicant and/or assignee is advised to draft the claims in such a way as to maintain a clear line of patentable distinction between the instant claims and the claims of the indicated patent applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents: 3061325 to Glass teaches the use of a longitudinally movable binding member, 6126179 to Dodge teaches the use of notches on a boot sole being positioned at different heights, 6276708 to Hogstedt teaches the use of outwardly and upwardly extending support members, 6302428 to Jungkind, 6923578 to Anderson

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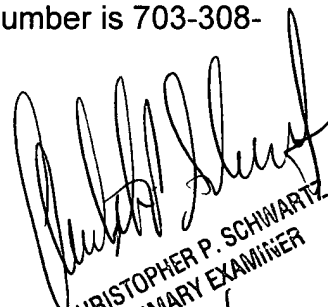
et al., 6193245 to Vensel, 6189913 to Morrow et al., 6168173 to Reuss et al., 6050589 to Couderc et al., 5954358 to Bejean et al., 5564719 to Kisselmann, 5505478 to Napoliello, and 4973073 to Raines et al. teach similar snowbinding structures.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mmb 4/18/02
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April 18, 2002


CHRISTOPHER P. SCHWARTZ
PRIMARY EXAMINER
4/21/02

